

Application Number 09/649,259
Art Unit 2125

REMARKS

This response is filed to place the above-referenced case in condition for immediate allowance. Applicant has amended claims 1 and 23. Specifically, Claims 1 and 23 have been amended to more clearly incorporate the novel features of the invention. Antecedent basis for the amendments to Claim 1 is found in the Specification, Page 7, lines 14-22 and Page 8, lines 8-12. Antecedent basis for the amendments to Claim 23 is found in the Specification, Page 13, lines 2-10 and Page 13, lines 11-16. No new matter has been added. Reexamination and reconsideration of the application, as amended, are requested.

Response to §103(a) Rejection Based Upon *Khazaka* in view of *Bromley*

The Examiner rejected Claims 1-44 under U.S.C. § 103(a) as being unpatentable over *Khazaka* in view of *Bromley*. As a basis for the rejection, the Examiner has stated that "it would have been obvious to a person of ordinary skill in the art at the time of invention to modify the teaching of *Khazaka* with the teaching of *Bromley* in order to provide proactive, efficient service to clients and maintain the client relationship."

20 35 U.S.C. § 103(a) states

25 "[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

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In applying § 102(b), MPEP § 706.02(a) instructs, “[i]n a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made.” MPEP §706.02(a) (page 700-21).

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The MPEP teaches:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaech, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

See MPEP § 706.02(j), page 700-46 (Emphasis added).

20 Also, the Supreme Court of the United States has ruled, that obviousness under 35 U.S.C. 103(a) has three factors, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the pertinent art. Graham v. John Deere Co., 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ 459, 467 (1966).

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In response, the Applicant respectfully traverses this rejection based on § 103(a) because neither the references nor the knowledge available to those skilled in the art suggest combining the references. In addition, neither the prior art references cited by the Examiner, nor their combination, teach or suggests all of the claim limitations of the Applicant's claims, as amended.

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NO SUGGESTION EXISTS IN THE REFERENCES NOR KNOWLEDGE
AVAILABLE TO THOSE SKILLED IN THE ART THAT SUGGESTS COMBINING
KHAZAKA AND BROMLEY

5 As the Federal Circuit Court of Appeals teaches, references may not be combined where
there is no suggestion in either of the references that they can be combined to meet the recitation
of the Applicant's claims. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572,
221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) Upon review of the two references cited by the
Examiner, there is no suggestion in either the references or in knowledge available to those
10 skilled in the art that would suggest combining the references.

The U.S. Court of Customs and Patent Appeals teaches, "[w]hether a combination of
references negates patentability depends solely upon what the references would reasonably and
realistically teach those of ordinary skill in the art." *In re Free*, 329 F.2d 998, 141 U.S.P.Q. 238,
15 240 (C.C.P.A. 1964). Therefore, either the *Khazaka* reference or the *Bromley* reference must
reasonably and realistically teach or suggest to those of ordinary skill that the two references
should be combined with each other. A review of these two references shows that such a
teaching or suggestion cannot be found.

20 Specifically, *Khazaka* teaches a system and method for managing contact information
based on use of a communications device, such as a mobile phone. *See* Col. 2, lines 13-16. The
invention in *Khazaka* allows a user to manage contact information based on information
automatically obtained through use of the mobile phone. *See* Col. 2, lines 16-19. The invention

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allows the user to store traditional contact information such as name and telephone number in the contact manager. *See* Col. 2, lines 19-21.

5 *Bromley*, on the other hand, teaches a financial planning system incorporating relationship and group management. *Bromley* provides a system that allows a financial advisor to provide service to clients through the use of the group management system of the invention. *See* Col. 4, lines 21-24. The system is a work management tool that organizes an advisor's day-to-day operations. *See* Col. 4, lines 25-27. The system allows the financial advisor to analyze an individual's relationship with his/her family, business and pension to provide overall financial 10 planning advice. *See* Col. 4, lines 29-33.

15 The teachings of the two references relate to completely different technology and the systems taught in the two references are used in completely different contexts. Accordingly, the *Khazakai* and *Bromley* devices are used for different purposes, and there is no reasonable or realistic teaching or suggestion to those of ordinary skill that *Khazaka* should be combined with *Bromley*. The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an Applicant's claims are obvious. Therefore, the *Khazaka* and *Bromley* references may not be combined to make an obviousness rejection.

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THE LIMITATIONS IN APPLICANT'S CLAIMS TO BEYOND ANY
REASONABLE COMBINATION OF THE DISCLOSURE IN KHAZAKA AND
BROMLEY

5 Even if the Examiner finds that there is some suggestion to those of ordinary skill in the art to combine the two references, the references when combined must teach or suggest all the claim limitations. In this instance, Applicant's claims 1 and 23, as amended, go beyond any reasonable combination of the prior art references. Claims 2-22 and 24-44 are dependent on claims 1 and 23 respectively, and thus contain all of the limitations of the independent claims.

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Applicant has now in Claim 1 specifically claimed the novel features of the invention that are described in the specification. Namely, the step of "assigning a contact frequency to the relationship" has been more clearly claimed, additionally requiring that "contact frequency be chosen to optimally cultivate said relationship". Also, the step of "contacting the user at the contact frequency with a first message regarding the relationship" has been more clearly claimed, additionally requiring this first message to be "in the form of a reminder providing the user with information unique to said relationship". Claim 23, which is an apparatus claim, has been similarly amended to add the above limitations.

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Neither of the two references cited by the Examiner even remotely discloses any of the above elements of Applicant's amended claims. The Examiner asserts that *Khazaka* discloses all the limitations of the Applicant's claims, except "classifying the relationship," providing the user information based on the classification of the relationship"; and " a first message comprises gift

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recommendations; activity suggestion, topic of conversion, information about a vendor and

prewritten correspondence.” However, the Examiner states that *Bromley* discloses “classify the

relationship” (Col. 19, line 65 – Col. 20, line 55); “provide to the user information based on the

classification of the relationship” (Col. 18, lines 37-63); “a first message comprises gift

5 recommendations; activity suggestion, topic of conversion, information about a vendor and

prewritten correspondence” (Col. 10, lines 48-64).

Although the Applicant disagrees with the Examiner’s assertions that *Bromley* discloses

the elements of Applicant’s claims not disclosed by *Khazaka*, the Applicant has amended the two

10 currently pending independent claims to include two additional limitations each. These

limitations are not disclosed in *Khazaka* or in *Bromley* in any way, shape or form. Therefore,

even assuming that *Bromley* may have been combined with *Khazaka* to disclose the limitations

of claims 1 and 23 previously, these references now fail to disclose all of the limitations of

claims 1 and 23, as amended by the Applicant.

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As described above, the inventions described in *Khazaka* and *Bromley* are used in

contexts that are very different from the context of the Applicant’s invention. The Applicants

invention is a method and apparatus that allows users to optimize, manage and schedule their

own personal relationships. Applicant’s system is designed to optimize the user’s relationship

20 with relatives and acquaintances by assigning a specific number of suggested contacts with them

per certain period of time, and by sending the user reminders that this assigned number of

contacts should be made. The inventions in the two references cited by the Examiner are very

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far removed and one of ordinary skill in the art would not be motivated to modify either of these references to form the Applicant's invention.

When compared against the Applicant's claims, as amended, *Khazaka* alone, or in combination with *Bromley* or any other references, does not teach or suggest all of the elements claimed by the Applicant in the amended claims 1-44. Accordingly, the 35 U.S.C. 103(a) rejection of Applicant's claims 1-44 in view of these two references is not proper and should be withdrawn.

10 **Conclusion**

The Examiner is respectfully requested to reconsider his position in view of the amendments and remarks made herein and the distinctions now set forth. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested.

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If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at (310) 777-8399.

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Respectfully submitted,

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